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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 02/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,710

Applicant(s)

FLANIGAN ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 30, 31, 33-35 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 29 and 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 7 & 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 36-52 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Applicant's election of Group I, claims 1-35 and 53-55, in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

2. Claim 24 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 22 and 24 recite the same limitation "the second major surface is a non-structured surface". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. **Claims 1-35 and 53-55** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitations "structured" and "non-structured" in claims 1, 6, 8, 9, 18, 20-24, 27-29, 53 and 54 are deemed vague and indefinite. Clarification is requested.

Claim 6 recites the limitation "the adhesive layers" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The recitation "the cap layer is a laminate" in claim 19 is deemed vague and indefinite. Clarification is requested.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-9, 11, 18-20, 22, 24, 26 and 27** are rejected under 35 U.S.C. 102(b) as being anticipated by Goepfert et al. (2,667,436).

Regarding **claims 1 and 22**, Goepfert et al. discloses an article comprising at least one adhesive layer (Fig. 3, #2) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, and a cap layer (Fig. 3, #3) in contact with a structured surface of an adhesive layer (Fig. 3, #2). Regarding **claim 2**, the cap layer is a backing (Fig. 3, #3). Regarding **claims 3 and 4**, the at least one adhesive layer comprises a pressure sensitive adhesive (see col. 3, line 43 and col. 5, line 62). Regarding **claim**

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5, the article has a thickness of about 2 μm to about 500 μm (see col. 4, lines 69-71). Regarding **claim 6**, the adhesive layers are selected from the group consisting of structured and non-structured adhesive layers (Fig. 3, #2; also see col. 5, lines 6-11). Regarding **claim 7**, note the article further comprises at least one non-adhesive layer in contact with the second major surface (Fig. 3, #1). Regarding **claim 8**, note the article comprises a structured exposed surface (Fig. 3, #3). Regarding **claim 9**, note the article comprises a non-structured exposed surface (Fig. 3, #1). Regarding **claim 11**, note the article comprises a plurality of channels (Fig. 1, #5). Regarding **claim 18**, the cap layer is a structured layer (Fig. 3, #3). Regarding **claim 19**, the cap layer is a laminate (Fig. 3, #3). Regarding **claim 20**, the second major surface is a non-structured surface, the cap layer (Fig. 3, #3) contacts the first major surface, and wherein the article further comprises a backing layer (Fig. 3, #1) on the second major surface. Regarding **claim 26**, note a backing (Fig. 3, #1) adjacent the second major surface. Regarding **claim 27**, note the cap layer is a structured layer (Fig. 3, #3).

7. **Claims 28, 30, and 33-35** are rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun et al. (5,888,650).

Calhoun et al. discloses a laminate article comprising a first adhesive layer (Fig. 6a, #600) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 6a, #610), and a second adhesive layer (Fig. 6a, #600) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 6a, #610). Regarding **claim 30**, note a backing (Fig. 6a, #620) on the second major surface (Fig. 6a, #630) of the second adhesive layer (Fig. 6a, #600). Regarding **claim 33**, note a backing layer (Fig. 6a, #620) on the

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second major surface (Fig. 6a, #630) of the first adhesive layer (Fig. 6a, #600). Regarding **claim 34**, note the first adhesive layer (Fig. 6a, #600) has a first pattern of structures (Fig. 6a, #610) on the first major surface thereof and the second adhesive layer (Fig. 6a, #600) has a second pattern of structures (Fig. 6a, #610) on the first major surface thereof, and wherein the first pattern is substantially aligned with the second pattern. Regarding **claim 35**, the first pattern (Fig. 6c, #615) is misaligned with the second pattern (Fig. 6c, #615).

8. **Claims 53-55** are rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun et al. (5,087,494).

Calhoun et al. discloses an article comprising at least one first layer (Fig. 1, #12) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 1, #14); and a cap layer (Fig. 1, #18) in contact with a structured surface of the first layer, wherein the cap layer comprises an adhesive (see col. 6, line 24). Regarding **claim 54**, the cap layer (Fig. 1, #18) is non-structured. Regarding **claim 55**, the first layer comprises a polymeric film (see col. 3, lines 61-63).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 10,12,14, 15 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goepfert et al. (2,667,436) in view of Hata (WO 97/33946).

Goepfert et al. discloses an article comprising at least one adhesive layer (Fig. 3, #2) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, and a cap layer (Fig. 3, #3) in contact with a structured surface of an adhesive layer (Fig. 3, #2). However, Goepfert et al. fails to disclose the article comprising a plurality of discrete reservoirs, each reservoir having a void volume of less than 100 μ l and containing at least one deliverable or non-deliverable substance and a peel strength of at least 21-42 oz/0.5inch. Hata teaches in the analogous art a plurality of discrete reservoirs (Fig. 1a, #4), each reservoir having a void volume of less than 100 μ l (see page 7, lines 21-23) and containing at least one deliverable or non-deliverable substance (see page 3, lines 1-12) and a peel strength of at least 21-42 oz/0.5 inch (see page 14, lines 17-30) for the purpose of producing an article having at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a plurality of discrete reservoirs, each reservoir having a void volume of less than 100 μ l and containing at least one deliverable or non-deliverable substance and a peel strength of at least 21-42 oz/0.5 inch in Goepfert et al. as suggested by Hata in order to produce an article having at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface.

11. **Claims 13, 16 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goepfert et al. (2,667,436) in view of Sher et al. (6,197,397).

Goepfert et al. discloses an article comprising at least one adhesive layer (Fig. 3, #2) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, a cap layer (Fig. 3, #3) in contact with a structured surface of an adhesive layer (Fig. 3, #2) and a plurality of channels (Fig. 1, #5). However, Goepfert et al. fails to disclose the channels containing at least one deliverable or non-deliverable substance. Sher et al. teaches in the analogous art channels containing at least one deliverable or non-deliverable substance (see col. 5, lines 33-37) for the purpose of producing an article having at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the channels in Goepfert et al. with at least one deliverable or non-deliverable substance as suggested by Sher et al. in order to produce an article having at least one adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface.

12. **Claims 21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goepfert et al. (2,667,436) in view of Calhoun et al. (5,888,650).

Goepfert et al. discloses an article comprising at least one adhesive layer (Fig. 3, #2) with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface, and a cap layer (Fig. 3, #3) in contact with a structured surface of an adhesive layer (Fig. 3, #2). However, Goepfert et al. fails to disclose the second major surface being a structured surface. Calhoun et al. teaches in the analogous art a second major surface of an adhesive layer being a structured surface (Fig. 1d, #100) for the purpose of

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producing an article with an adhesive layer having a first major surface and a second major surface.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the second major surface of the adhesive layer in Goepfert et al. with a structured surface as suggested by Calhoun et al. in order to produce an article with an adhesive layer having a first major surface and a second major surface.

13. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (5,888,650) in view of Goepfert et al. (2,667,436).

Calhoun et al. discloses a laminate article comprising a first adhesive layer (Fig. 6a, #600) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 6a, #610), and a second adhesive layer (Fig. 6a, #600) having a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface (Fig. 6a, #610). However, Calhoun et al. fails to disclose a cap layer on the first major surface of the first adhesive layer. Goepfert et al. teaches in the analogous art a cap layer (Fig. 3, #3) on the first major surface of an adhesive layer for the purpose of producing a pressure-sensitive adhesive article.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the first major surface of the first adhesive layer in Calhoun et al. with a cap layer as suggested by Goepfert et al. in order to produce a pressure-sensitive adhesive article.

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Allowable Subject Matter

14. Claims 29 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents are cited for further teachings of adhesive articles similar to that instantly disclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.

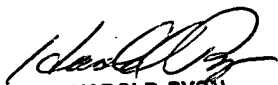
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone
Examiner
Art Unit 1772

February 10, 2003



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/10/03